



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/787,840

07/06/2001

Mark Leslie Smythe

36677.8

8048

27683 7590 07/06/2007
HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202

EXAMINER

KAM, CHIH MIN

ART UNIT

PAPER NUMBER

1656

MAIL DATE

DELIVERY MODE

07/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/787,840

Applicant(s)

SMYTHE ET AL.

Examiner

Chih-Min Kam

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-31, 35, 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10, 12-31, 35, 39 and 40 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. Claims 1-5, 7-31, 35 and 39-40 are pending.

Applicant's amendment filed April 25, 2007 is acknowledged, and applicants' response has been fully considered. Claims 1, 14, 15 and 24 have been amended. Therefore, claims 1-5, 7-31, 35 and 39-40 are examined.

Withdrawn-Claim Objections

2. The previous objection to claims 1 and 14 is withdrawn in view of applicant's amendment to the claim, and applicant's response at page 17 in the amendment filed April 25, 2007.

Withdrawn Claim Rejections - 35 U.S.C. § 112

3. The previous rejection of claims 1-5, 7-10, 14, 15, 17, 18, 20, 22, 24-31, 39 and 40 under 35 U.S.C. § 112, second paragraph (see paragraphs 8-10 in the previous Office Action dated January 8, 2007), is withdrawn in view of applicant's amendment to the claim, and applicant's response at pages 18-19 in the amendment filed April 25, 2007.

New Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-5, 7-10, 12-31, 35 and 39-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1656

5. Claims 1-5, 7-10, 12-31, 35 and 39-40 are indefinite because of the use of term "X is oxygen, sulfur, CH₂O- or CH₂S-" and/or "R³, R⁴ or R⁵ are each ... substituted alkyl, ... substituted aryl,substituted arylalkyl,.....substituted heteroaryl,". The term cited renders the claim indefinite, it is not clear whether the term "CH₂O- or CH₂S-" means that the XH group is "CH₂OH or CH₂SH" or "CH₃O- or CH₃S-" group. Regarding the term "substituted alkyl, ... substituted aryl,substituted arylalkyl,.....substituted heteroaryl ", it is not clear what group is used for substitution, where is the substitution in the group, and what structures these substituted alkyl, aryl, arylalkyl or heteroaryl groups have. Claims 2-5, 7-10, 12, 13, 14-31, 35 and 39-40 are included in the rejection because they are dependent on rejected claims and do not correct the deficiency of the claim from which they depend.

6. Claims 14, 15 and 35 are indefinite because of the use of the term "c) on resin cyclization", it is not clear what molecule is used in a method of on-resin cyclization. Claims 15 and 35 are included in the rejection because they are dependent on a rejected claim and do not correct the deficiency of the claim from which they depend.

Claim Objections

7. Claim 11 is objected to because the claims are dependent from a rejected claim.

Conclusion

8. Claims 1-5, 7-10, 12-31, 35 and 39-40 are rejected; and claim 11 is objected to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

Art Unit: 1656

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Bragdon can be reached at 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.
Primary Patent Examiner



CHIH-MIN KAM
PRIMARY EXAMINER

CMK

July 2, 2007